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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,985	01/04/2002	Steven N. Verona	VEROX 101	7751

7590

12/02/2005

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/037,985	VERONA, STEVEN N.	
	Examiner	Art Unit	
	Ovidio Escalante	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's response filed on October 20, 2005. **Claims 1-29** are now pending in the present application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20, 2005 has been entered.

Specification

3. The specification is objected to because the title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Response to Amendment

4. The Declaration filed on February 10, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome both Groner U.S. Patent No. 6,507,643 B1 and Baxter U.S. Patent No. 6,385,306 B1.

5. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Groner and Baxter reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

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2138.04 [R-1] Conception

Conception has been defined as "the complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice...." Townsend v. Smith, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." Hiatt v. Ziegler, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." Gunter v. Stream, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also Coleman v. Dines, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (**It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.**); Hybritech Inc. v. Monoclonal Antibodies Inc., 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice."); Hitzeman v. Rutter, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001) (Inventor's "hope" that a genetically altered yeast would produce antigen particles having the particle size and sedimentation rates recited in the claims did not establish conception, since the inventor did not show that he had a "definite and permanent understanding" as to whether or how, or a reasonable expectation that, the yeast would produce the recited antigen particles.).

The Examiner believes that Exhibit A, which was submitted on February 10, 2005 does not support all of the claimed limitations. For example claim 1 recites:

A communication method in which a caller uses a telephone system and the Internet to transmit an electronic message to at least one electronic address of an intended recipient, the method comprising:

(a) said caller dialing a telephone number via the telephone system for connecting to a central computer;

(b) said central computer comparing an intended recipient identifier with data corresponding to a plurality of subscribers;

(c) said caller inputting a communication code into the central computer via the telephone system;

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(d) said central computer constructing an electronic message addressed to at least one electronic address of the intended recipient, said electronic message containing information corresponding to the communication code; and

(e) said central computer transmitting the electronic message over the Internet to said at least one electronic address of the intended recipient.

Exhibit A does not disclose a caller connecting to a central computer, said central computer comparing an intended recipient identifier with data corresponding to a plurality of subscribers; said caller inputting a communication code into the central computer; central computer constructing an electronic message addressed to at least one electronic address of the intended recipient, said electronic message containing information corresponding to the communication code.

Exhibit A merely describes a subscriber having a "pager" number and indicating email and instant messaging address to have messages forward to and having a caller call the subscriber's "pager" number and leaving the call back number and wherein the call number is converted to an email message so that it can be sent to the indicated addresses. There is no mentioning of any central computer comparing the identifier as well as the central computer performing the rest of the limitations as described above.

Exhibit B does not further describe in detail any support for conception but only attempts to show diligence, therefore, the Examiner is maintaining that there is insufficient conception of the entire claimed invention.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Groner and Baxter reference to either a constructive reduction to

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practice or an actual reduction to practice. Since the Applicant does not have conception of the claimed invention then the applicant has not provided diligence for the claimed invention.

For the above reasons, the applicant's arguments and Declaration were not considered persuasive, and the following rejections are repeated.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 8-17, 18, 20, 23, 25, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,507,643 B1 to Groner ("Groner"), as used in the prior Office action.

With respect to claim 1, the caller dials a telephone number for connecting to a central computer (Fig. 1, calling telephone 32 and "voice to electronic" mail system 30, Fig. 11A, step 242). The "voice to electronic" mail system 30 (central computer) compares an intended recipient identifier (called telephone number) with data corresponding to a plurality of subscribers in a subscriber database (recipients e-mail addresses) in order to retrieve the correct e-mail address (Fig. 9 and col. 7, line 66 – col. 8, line 18).¹ The caller can also input a

¹ Interpreting a "intended recipient identifier" as a specific instance of the dialed telephone number is consistent with the applicant's claim structure (e.g., see claim 8).

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communication code, such as the caller's telephone number (Fig. 11C, step 282).² Groner clearly discloses that the "voice to electronic" mail system 30 (central computer) then constructs an e-mail message addressed to the electronic address of the intended recipient containing information corresponding to the communication code (calling party telephone number). The e-mail is transmitted via packet-based network 42, which in one embodiment is the Internet (col. 4, lines 44-48).

With respect to claims 8 and 9, see the claim 1 rejection for further details.

With respect to claim 10, the dialed telephone number comprises alphanumeric.

With respect to claim 11, see Fig. 11C, step 286.

With respect to claims 12-14 and 16-18, the IVR dialogue manager 104 accepts both verbal and touch tone responses (col. 11, lines 43-67).

With respect to claim 15, the calling telephone number would comprise pressing a plurality of touchtone buttons. See the claim 1 rejection for further details.

With respect to claim 20, see the claim 1 rejection for further details.

² Interpreting a "communication code" as the caller's telephone number is consistent with the applicant's claim

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With respect to claim 23, the e-mail address corresponds to the text display device, which is based is a computer and which is personal in nature (Fig. 1).

With respect to claim 25, see col. 7, lines 41-51.

With respect to claim 27, see Fig. 11D.

With respect to claim 28, reception of an e-mail with an voice attachment would notify the intended recipient of the recorded voice message (Fig. 7).

With respect to claim 29, see col. 4, lines 20-30.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-7 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groner as applied to claim 1 above, and further in view of U.S. Patent No. 6,385,306 B1 to Baxter, Jr. ("Baxter"), as used in the prior Office action.

structure (e.g., see claim 3).

With respect to claim 2, although Groner teaches that the caller may enter the recipient identifier directly, Groner fails to disclose that this identifier is compared with data identifying a plurality of subscribers (col. 16, lines 20-30).

However, Baxter (similarly to Groner) teaches of a system for allowing a telephone caller to generate an e-mail (abstract and Fig. 6), where the caller may enter the identifier directly (e.g., a "speed-dial" previously entered email address) that is compared to an address book (compared with data identifying a plurality of subscribers) (Fig. 6, step 240).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the caller inputting the intended recipient identifier that is compared with data as taught by the telephonic e-mail system of Baxter to the process of inputting the intended recipient identifier as disclosed by the telephonic e-mail system of Groner.

The suggestion/motivation for doing so would have been to allow speed dialing codes, which increase the efficiency and user-friendliness of recipient identification by avoiding the need for the "caller...to repeatedly enter in the same email addresses" via a limited capability DTMF interface (Baxter, col. 3, lines 14-23) and to "make the retrieval of the preselected email address as simple as possible (Baxter, col. 6, lines 32-40).

With respect to claims 3 and 5, see the claim 1 rejection for further details.

With respect to claim 4, see Groner, col. 11, lines 60-67.

With respect to claim 26, see the claim 2 rejection for further details for addition of subscriber's address book facility, where the user modifies electronic (e-mail) addresses stored in the address book. Further, "Official Notice" is taken that both the concept and advantage of allowing the user to access this address book for modification purposes via the Internet would have been well known and expected in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make modification of electronic addresses in the address book disclosed by Groner in view of Baxter available via the Internet.

The suggestion/motivation for doing so would have been to increase the accessibility of user data by providing that data via the Internet, which would have been notoriously well known in the art.

With respect to claim 6 and 7, the IVR dialogue manager 104 accepts both verbal and touch tone responses (Groner, col. 11, lines 43-67).

Claims 19, 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groner as applied to claims 1, 18, 20 above.

Although Groner discloses sending the e-mail to a text display device (Fig. 1), Groner fails to disclose that this text display device processes instant messaging and web mail and whether the device is a PDA or wireless.

However, "Official Notice" was taken in the last Office action that both the concept and advantages of a personal text display devices processing instant messaging and web mail in the form of PDAs and wireless devices would have been well known and expected in the art. The applicant's lack of traverse to the officially noticed fact in the last Office action is taken as an admission of the facts noticed.

Therefore, it would have been obvious to add to the text display device disclosed by Groner the processing of instant messaging and web mail in the form of a PDA and wireless device.

The suggestion/motivation for doing so would have been to increase the accessibility and reach of e-mail devices by supporting web mail and instant messaging and to support typical e-mail devices such as PDAs and wireless pagers and phones as is notoriously well known in the art.

Conclusion

10. Any response to this action should be mailed to:

Commissioner for Patents

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P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**OVIDIO ESCALANTE
PATENT EXAMINER**

Ovidio Escalante
Primary Patent Examiner
Group 2645
November 18, 2005

Ovidio Escalante

O.E./oe